

**REMARKS**

The Office Action mailed January 13, 2004 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-45 were pending in the application, with claims 23-29 being provisionally withdrawn. Claims 1 and 12 have been amended and no claims have been canceled or newly added. Therefore, claims 1-45 are pending in the application and claims 1-22 and 30-45 are presented for reconsideration.

As a preliminary matter and as requested in the Amendment filed on October 3, 2003, applicants request that the examiner acknowledge the Proprietary Information Disclosure Statement filed on September 28, 2001, and indicate whether the submitted reference is material as required under M.P.E.P. §724.

Applicants sincerely thank the examiner for indicating that claims 4, 5, 15, 16, and 30-45 are allowed.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

The Office Action Summary indicates that claims 23-29 remain withdrawn from consideration. However, applicants request the rejoinder of claims 23-29 since method claim 23 includes all of the limitations of allowed product claim 4. See MPEP 821.04 and *In re Ochiai* which mandate rejoinder in this situation.

Claims 1-3, 6-14, and 17-22 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In reply, applicants have amended the independent claims 1 and 12 and the specification is believed to provide written description support to these claims. Specifically, the features recited in the amended independent claims are supported in the specification at least at page 6, lines 21-25 and page 14, lines 4-7, for example. Accordingly, applicants believe that the specification provides adequate written description support for the pending independent claims which meet the requirements of 35 U.S.C. § 112, first paragraph.

Furthermore, the features recited in the pending independent claims 1 and 12 are not disclosed or suggested by the cited prior art. For example, pending claim 1 recites that the thickness of the nickel-based coat is not less than the arithmetical mean roughness Ra of the

of a base metal of a rolling contact surfaces (i.e., the coat is thicker). This specific relationship is not taught or suggested by any of the applied references. Specifically, neither Nakano (U. S. Patent No. 4,955,246) nor Ward disclose anything related to this claimed limitation. Grell specifically teaches the opposite of the claimed relationship since it discloses that anti-corrosive coating being thinner than the surface roughness which the hardened component had before application of the protective coating. See, e.g., col. 1, lines 39-42 of Grell. Furthermore, Grell teaches that this thin coating is important to its principle of operation since it requires that the “applied anti-corrosive coating penetrates into the roughness profile of the surface and this exercises no negative influence on the tolerances of the component.” See col. 2, lines 11-16 of Grell. Therefore, claim 1 and claim 12 (which recites a similar limitation to that discussed above with respect to claim 1) are believed to be allowable over the applied prior art.

The rejected dependent claims are also in condition for allowance for at least the same reasons, as discussed above, as the respective independent claim on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

In view of the foregoing amendments and remarks, applicants respectfully request entry and consideration of the instant amendment and reply because it is believed to place the application in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

Date April 9, 2004

FOLEY & LARDNER LLP

Customer Number: 22428

Telephone: (202) 945-6162

Facsimile: (202) 672-5399

By Aaron C. Chatterjee

Richard L. Schwaab

Registration No. 25,479

Aaron C. Chatterjee

Registration No. 41,398

Attorneys for Applicants